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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,782	01/29/2001	Daniel P. Kelly	A00219US (98361.3)	8325
7590	06/28/2004		EXAMINER	
GARVEY, SMITH, NEHRBASS & DOODY, L.L.C. Three Lakeway Center, Suite 3290 3838 North Causeway Boulevard Metairie, LA 70002-1767			LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/771,782

Filing Date: January 29, 2001

Appellant(s): KELLY, DANIEL P.

Seth Nehrbass
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/15/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant has not given reason for separate patentability in the "Argument" section.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Admitted prior art as set forth on page 1 of the instant specification.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 37-43 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateholts (USPN 1958841) in view of the admitted prior art as set forth on page 1 of the instant specification. This rejection is set forth in a prior Office Actions, mailed on 10/7/2003 and 3/31/2003.

(11) *Response to Argument*

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion or motivation to combine or modify the teachings of Bateholts with the admitted prior of record is to produce diverse product lines of beaded necklaces, i.e., beaded necklaces with varying designs which have appeal to a wide range of customers, and is found in knowledge generally available to one of ordinary skill in the art.

The declarations under 37 CFR 1.132 filed 10/31/02, 1/23/03, 1/29/03, 7/31/03 and 4/7/04 are insufficient to overcome the rejection of claims 37-43 and 47-49 based upon the 35 USC 103(a) rejection as set forth in the last Office action because:

Commercial Success argument

- A nexus between the claimed process and evidence of commercial success has not been established. MPEP 716.03(a). There is no evidence that whatever commercial success may have occurred is attributable to the process defined by the claims. MPEP 716.03(a).
- Conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). MPEP 716.03(b).
- Merely showing that there is commercial success of an article which embodied the invention is not sufficient. MPEP 716.03(b).
- Gross sales figures do not show commercial success absent evidence as to market share, or as to the time period during which the product was sold, or as to what sales would normally be expected in the market. MPEP 716.03(b).

Copying argument

- More than the mere fact of copying is necessary to make copying significant because copying may be attributed to other factors such as a lack of concern for patent property or contempt for the patentee's ability to enforce the patent. MPEP 716.06.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

EDMUND H. LEE
Primary Examiner
Art Unit 1732

Edmund Lee 6/24/04.

EHL
June 24, 2004

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